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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/681,749	10/07/2003	Philipp Lang	2960/112	8140

75059 7590 12/14/2007  
BROMBERG & SUNSTEIN LLP  
125 SUMMER STREET  
BOSTON, MA 02110-1618

EXAMINER
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PHILOGENE, PEDRO

ART UNIT	PAPER NUMBER
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3733

MAIL DATE	DELIVERY MODE
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12/14/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/681,749

Applicant(s)

LANG ET AL.

Examiner

Pedro Philogene

Art Unit

3733

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 28 September 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-122 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-122 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 11/9/07, 12/3/07
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application
- ☐ Other: \_\_\_\_\_

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 113-122 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. See MPEP § 2172.01. The omitted steps are: determining three-dimensional shapes of one or more articular surface of the joint; and producing an implant having a first surface and a second surface that matches the three-dimensional shape of the articular surface.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-36, 38-122 are rejected under 35 U.S.C. 102 (b) as being anticipated by Fell et al. (6,652,587).

With respect to claims 1, 34, 70, 76, 79-90, 93, 97,98,110, Fell et al. disclose an articular implant having a first surface and a second surface wherein the first surface

opposes a first articular surface joint and the second surface opposes a second articular surface of the joint, as best seen in the FIGS; and further wherein a portion of at least a portion of each of the first and second surfaces has a three-dimensional shape that substantially matches the shape of one of the first and second articular surfaces, so as to have a plurality of convexities and a plurality of concavities, such that the movement of the implant in the joint is limited without an attachment mechanism; as set forth in column 4, lines 20-67, column 5, lines 1-67, column 6, lines 1-67, column 7, lines 1-67, column 8, lines 1-67, column 12, lines 40-67, column 13, lines 1-10, column 14, lines 50-60, column 17, lines 50-67, column 18, lines 1-67, column 19, lines 1-67, column 20, lines 1-67 column 21, lines 1-67, column 22, lines 1-67 column 23, lines 1-67. As to a first component of the plurality of components engages a second component of a plurality of components in at least one of slidably and rotatably, see column 13, lines 10-67, column 14, lines 1-67, column 15, lines 1-58, and as best seen in the FIGS.

With respect to claims 2-33, 35-36, 38-69, 94-96, 99-109, 111, 112, Fell et al discloses all the limitations, as set forth in column 4, lines 20-67, column 5, lines 1-67, column 6, lines 1-67, column 7, lines 1-67, column 8, lines 1-67, column 12, lines 40-67, column 13, lines 1-10, column 14, lines 50-60, column 17, lines 50-67, column 18, lines 1-67, column 19, lines 1-67, column 20, lines 1-67 column 21, lines 1-67, column 22, lines 1-67 column 23, lines 1-67.

With respect to claims 70-78, 91, 92, 113-122, the method steps, as set forth, would have been inherently carried out in the operation of the device, as set forth above.

***Response to Amendment***

Applicant's arguments filed 9/28/07 have been fully considered but they are not persuasive. Felt et al inherently disclose at least an articular surface having a three-dimensional shape that substantially matches the shape of one of the first and second articular surfaces so as to have a plurality of convexities and a plurality of concavities, since the mold of Felt et al conform to the shape of the articular surface. Felt et al disclose, in column 4, lines 60-67, "The optional ability to finally form one or more components in situ provides various additional benefits, such as increased control over the overall size and shape of the final prosthesis, improved shape and compliance of the surface apposing natural bone, and finally improved shape and compliance of the opposite, articulating bone surface". Therefore, it could clearly be seen that Felt et al discloses a shape that match the articulating surface of the bone. In column 6, lines 5-21, again Felt et al disclose "A component can e "specifically" formed in this manner in order to conform the component (and particularly its surface) to the corresponding specific shapes and dimension of bone in situ including both supporting bone surfaces and/or opposing (e.g., articulating) bone surfaces.... " Therefore, applicant's arguments that Felt et al did not teach an implant in which a portion or at least a portion of each one of the first and second surfaces has a three-dimensional shape that substantially matches the shape of one of the first and second articular surfaces is not persuasive. The mold of Felt is adapted to be inserted and positioned within the joint site in order to enhance conformance.

***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pedro Philogene whose telephone number is (571) 272-4716. The examiner can normally be reached on Monday to Friday 6:30 AM to 4:00 PM.

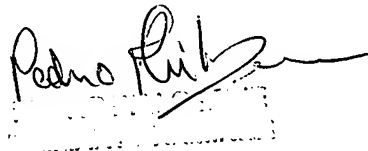
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached on (571) 272 - 4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Pedro Philogene  
December 4, 2007

A handwritten signature in black ink, appearing to read "Pedro Philogene", is written over a rectangular dashed-line box.